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Attorney Docket No. 65678-0003 (1-21739)

and 21-42 as being unpatentable pursuant to 35 U.S.C. 103(a). Applicants respectfully traverse the rejection.

**I. EXAMINER CONTINUES TO INVOKE OFFICIAL NOTICE TO REJECT APPLICANTS' CLAIMS**

In the Office Action, Official Notice was once again invoked (pages 3, 5, and 7) to support the rejection of Applicants' claims. Pursuant to 37 CFR 1.104(d)(2) and MPEP § 2114.03, the Applicants have consistently requested that assertions of Official Notice be supported by sworn affidavits, or limited to the scope of references cited by the Examiner. However, no affidavit has been provided by the Examiner. The Office Action does cite additional references in conjunction with the assertion of Official Notice, however those references do not support the scope of Official Notice as asserted in the Office Action. Moreover, the references cited in support of Official Notice do not support or even suggest, the combination of references as asserted by the Examiner. In a decision by the U.S. Court of Appeals for the Federal Circuit just last month, the Federal Circuit provided that neither the Board of Patent Appeals nor patent examiners can "rely on conclusory statements when dealing with particular combinations of prior art and specific claims." *In re Sang Su Lee*, 2002 U.S. App. LEXIS 855, at \*17-18 (Fed. Cir. January 18, 2002). A copy of this recent decision is included with this response. The results of in the *In re Sang Su Lee* decision is consistent with the Applicants' prior analysis regarding the requirements of 37 CFR 1.104(d)(2) and MPEP § 2114.03. The references cited by the Examiner do not include the functionality claimed as Applicants' invention. Moreover, the references cited by the Examiner do not suggest combination in the manner asserted by the Examiner. Thus, the Examiner's rejection of Applicants' claims is traversed.

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**II. THE ADDITIONAL REFERENCES CITED IN THE OFFICE ACTION DO NOT SUPPORT A FINDING OF OBVIOUSNESS**

As mentioned above, the Applicants thank the Examiner for providing the additional references in the Office Action. However, those references do not render Applicants' claims obvious.

For example, the Ryder reference ("Ryder") fails to disclose any of the steps in method claim 16. Ryder does not disclose "generating a warranty report if the amount of usage is less than the predetermined standard." The words "report" and "usage" do not even appear within the disclosure. There is no mention in the Ryder disclosure of "generating a maintenance invoice" in a manner that does not require "human intervention." Similarly, the step of automatically "transmitting the maintenance invoice to an administrative controller" is not disclosed by Ryder, because neither a "maintenance invoice" nor an "administrative controller" are disclosed.

Ryder does disclose the step of automatically informing a technician if a repair is covered by warranty. However, there is no mention in Ryder of "comparing the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period." Thus, the exact warranty-application methodology of Ryder is not disclosed. Other non-usage based methodologies can exist, and thus Ryder cannot be presumed to preclude the patentability of Applicants' claims. Moreover, there is no basis for asserting that Ryder discloses the other three steps in claim 16, and thus the Examiner's rejection is traversed.

The response of the Examiner to the Applicants' claims is to summarily assert obviousness in a highly conclusory manner. For example, on Page 7, the Office Action provides that the "Examiner takes Official Notice that an entity who performs service on an asset for a second entity and generates a warranty report and/or maintenance invoice, and warranty handling is well known to those of ordinary skill in the art." This particular assertion by the Examiner includes more elements than are found in some of Applicant's broader claims (such as claim 16), and yet the Examiner simply concludes that the totality of the various elements and limitations

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are obvious. Such an assertion goes against the recent decision in *In re Lee*, and other binding precedents, policies, and rules.

### CONCLUSION

Claims 16, 21-42 are not rendered obvious by the references cited by the Examiner. In view of the analysis above, the pending claims are in condition for allowance. If the Examiner has any questions or issues relating to Applicants' response, he is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Date: March 13, 2002

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